

### **REMARKS**

This paper is responsive to the outstanding Office Action mailed July 7, 2006. After entering this response, claims 1-12, 15-20, 22, 24-29 and 31-32 are pending. Claims 9, 16, 20 and 33 have been cancelled and claims 1, 12, 17 and 22 have been amended. The support for the amendments is present in at least paragraphs [0038] – [0041] and FIGS. 2 and 5.

In view of the Amendments and the arguments made below, it is believed that the claims are now in condition for allowance. The Applicant therefore respectfully requests reconsideration and withdrawal of the rejection.

#### **Claim Rejections-35 U.S.C. § 102**

##### **Independent Claims 1, 12, 17 and 22 Are Not Anticipated by Bachinski**

Independent claims 1, 12, 17 and 22 were rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Pat. Publication No. 2004/0011352 to Thomas J. Bachinski et al. (“Bachinski”). The Applicant respectfully submits that Bachinski does not teach, suggest or disclose a fireplace surround that includes all of the features recited in claims 1, 12, 17 and 22. Claims 1, 12, 17 and 22 also do not read upon the disclosure in Bachinski. Applicant therefore respectfully requests reconsideration and withdrawal of this rejection.

Bachinski discloses a fireplace with an “exposed panel defining an exposed surface” wherein the exposed panel further includes a touch portion that is “isolated from heat generated within the combustion chamber.” Abstract. The touch portion includes a control circuit for the fireplace. The front panel 103 includes grills 150 and 160 and the fireplace may include a surround positioned in front of front panel 403. The surround can be used to “thermally isolate the activation portion 415 from the heat generated by the fireplace 400” by placing the surround in a spaced apart relationship from front panel 403 or by forming the surround with and insulative material. See par. 38.

In contrast, claims 1 and 12 recite a fireplace or fireplace surround that includes a top member with a “front facing side and a rear facing side in a spaced apart relationship” wherein the top member defines a cavity “between the front and rear facing sides.” Claim 17 recites a fireplace surround that includes “a molded first member having first and second sides in a spaced apart relationship” with “a cavity formed within the first member between the first and second sides” and “an insulating member positioned in cavity of the first member between the shield and

the second side.” Claim 22 recites a method of forming a fireplace including “forming a first member” that includes “a front facing side and a rear facing side” that are “in a spaced apart relationship” and “forming an opening in the first member.” Claim 22 further recites “positioning an insulating member in the cavity adapted to dissipate heat.”

Bachinski does not teach, disclose or suggest the formation of a cavity between a front and rear facing side of the top member (claims 1 and 12) or forming an opening and a cavity in the first member, wherein the opening extends through the first member from the rear facing side to the front facing (claims 17 and 22). Furthermore, Bachinski does not teach, disclose or suggest an insulating member placed between the shield and the front facing side of the top member (claims 1 and 12), in the first member between the shield and the second side of the molded first member (claim 17) or in the cavity of the first member (claim 22). Rather, the surround in Bachinski is simply placed in a spaced apart relationship to the fireplace or is formed of a flat piece with a hole in it. In addition, Bachinski does not include an insulating member placed within the cavity or an insulating member between the shield and the front face of the surround.

Bachinski, therefore, does not teach, disclose or suggest the invention as claimed in claims 1, 12, 17 and 22. In addition, claims 1, 12, 17 and 22 do not read upon the fireplace and fireplace surrounds claimed in Bachinski. For at least these reasons, reconsideration and withdrawal of the rejection based upon Bachinski is respectfully requested.

In addition, dependent claims 2-11, 15-16, 19-20, 24-29 and 30-31 depend directly or indirectly from independent claims 1, 12, 17 and 22 and are therefore also allowable for at least these same reasons.

#### **Claim Rejections-35 U.S.C. § 103**

Claims 1, 12, 17 and 22 are not Obvious over Duffney in view of Schroeter

Independent claims 1, 12, 17 and 22 were rejected under 35 U.S.C. § 103(a) in view of U.S. Pat. No. 6,409,870 to Timothy Duffney in view of U.S. Patent no. 5,307,801 to Wolfgang Schroeter et al. (“Schroeter”). The combination of Duffney and Schroeter, however, does not teach, disclose, or suggest all of the limitations of independent claims 1, 12, 17 and 22. Further, independent claims 1, 12, 17 and 22 do not read upon the combination of Duffney and Schroeter. Claims 1, 12, 17 and 22 are therefore in a condition for allowance.

Duffney discloses a decorative molding that may be used as a fireplace surround. The decorative molding includes a frame 11 that may include a "plurality of artistic cutouts 20" that are formed "through the front face section 18" of the frame 11. Col. 4, lines 42-44. "A longitudinal groove 2 is preferably centrally milled within the rear surface 22" of the frame 11. *Id.* at lines 59-61. "A filler material 30 having a colored surface 32 is preferably positioned within the longitudinal groove 24 and is further preferably secured to the first interior surface" of the frame 11. Col. 5, lines 7-9.

In contrast, as recited above, claims 1 and 12 recite a fireplace or fireplace surround that includes a top member with a "front facing side and a rear facing side in a spaced apart relationship" wherein the top member defines a cavity "between the front and rear facing sides." Claim 17 recites a fireplace surround that includes "a molded first member having first and second sides in a spaced apart relationship" with "a cavity formed within the first member between the first and second sides" and "an insulating member positioned in cavity of the first member between the shield and the second side." Claim 22 recites a method of forming a fireplace including "forming a first member" that includes "a front facing side and a rear facing side" that are "in a spaced apart relationship" and "forming an opening in the first member." Claim 22 further recites "positioning an insulating member in the cavity adapted to dissipate heat."

Moreover, as further noted above, each claim recites a shield portion or an insulative material that is configured to fit within a portion of the cavity between the vent and the front face of the surround. Duffney only discloses forming decorative cutouts and placing a colorful backing on the inside of the surround such that it appears through the cutout. The backing is never configured or placed within the cutout and the backing is not adapted to dissipate heat. Duffney furthermore does not disclose air flowing through the cutouts or the backing placed between the vent and the front face of the surround. Rather, if the backing was placed between the vent and the front face of the surround it would completely stop the air flow out of the vent.

Schroeter does not remedy his failure as it does not disclose a cavity and a shield or an insulative material configured to fit within a portion of the cavity or to be positioned between the vent and the front of the surround to dissipate heat.

Reconsideration and withdrawal of the rejection of claims 1, 12, 17 and 22 is therefore respectfully requested. In addition, dependent claims 2-5, 8-10, 15, 20, 24-26 and 29 depend directly or indirectly from independent claims 1, 12, 17 and 22 and are therefore also allowable for at least these same reasons.

The Remaining Claims are not Obvious in View of the Remaining Cited Art

Claims 6, 7, 11, 16, 27, 28, 31 and 32 were furthermore rejected as obvious over various combinations of Duffney, Schroeter, U.S. Patent No. 6,026,805 to Tracy J. Burch et al., and U.S. Patent No. 3,758,317 to Earl P. Moore et al. Each of these claims, however, is directly or indirectly dependent on one or more of independent claims 1, 12, 17 and 22. Claims 6, 7, 11, 16, 27, 28, 31 and 32 are therefore allowable for at least the same reasons as given above. Withdrawal of the rejection of claims 6, 7, 11, 16, 27, 28, 31 and 32 is therefore respectfully requested.

CONCLUSION

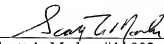
No fee is believed to be necessary for the entry of this paper. Should any fee be required for entry of this paper, the Commissioner is authorized to charge the Faegre & Benson Deposit Account No. 06-0029 and in such event, is requested to notify us of the same.

All of the claims remaining in this application should now be seen to be in condition for allowance. The prompt issuance of a notice to that effect is respectfully solicited. If there are any remaining questions, the Examiner is requested to contact the undersigned at the number listed below.

Respectfully Submitted,

FAEGRE & BENSON LLP

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